



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,608	07/26/2001	Nicholas W. Fenton	041892-0217 50R4644.03	6785

7590 06/10/2004

Ted R. Rittmaster  
FOLEY & LARDNER  
Suite 3500  
2029 Century Park East  
Los Angeles, CA 90067-3021

EXAMINER
----------

LE, UYEN T

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/915,608

Applicant(s)

FENTON ET AL.

Examiner

Uyen T. Le

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 20-39 and 43-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 20-39 and 43-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3, 7, 8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because the status of related applications has not been updated.

Appropriate correction is required.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bandwidth determination, the parameter setting, the creation of showcase pages and advertisements, the visual display of time measurement, the windows that slide back and forth periodically must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

Art Unit: 2171

per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 14-17, 59, 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because:

- Claim 3, it is not clear what applicant intend to mean by “wherein the graphical index is implemented in Flash”
- Claim 21, it is not clear what applicant intend to mean by “the graphical advertising unit is implemented in Flash”
- Claim 14, 59, it is not clear whether downloading is performed on the same “at least one computer system” for both the first and second time.

The art rejection of claims 3, 14-17, 21, 59, 60 is applied as best understood in light of the rejection under 35 U.S.C. 112, second paragraph discussed above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2171

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4-13, 55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Barrera et al (US 6,567,800).

Regarding claim 1, Barrera discloses all the claimed subject matter (see column 5, lines 17-31). The claimed storage device is met by item 506. The claimed display device is shown in Figure 7. The claimed processor is met by item 505. The processor clearly is programmed to perform all the claimed operations since the website contents are correlated with categories, subcategories and stored (see column 3, lines 51-67). The claimed add content, modify content and update dynamically the display are met by the fact that the index in Barrera is dynamic (see column 4, line 35- column 6, line 4).

Claim 55 essentially is a broader version of claim 1, thus is rejected for the same reasons stated in claim 1 above.

Regarding claims 2, 56, Barrera discloses sorting the plurality of categories and subcategories into at least one hierarchy and displaying as claimed when Barrea shows the list of identifiers of web sites that correspond to categories (see column 5, lines 17-31).

Regarding claims 4, 57 the claimed server network device operating as claimed has to be present for the system of Barrera to allow the operations shown in Figure 6.

Claim 5 merely reads on the fact that the user can view search results on his or her device (see Figure 8).

Regarding claims 6, 58, Barrera discloses the network comprises the Internet and the user interface comprises a website (see Figures 5, 8, 9).

Regarding claim 7, Barrera discloses displaying the graphical index within a web page on the website (see Figure 8).

Regarding claim 8, Barrera discloses the plurality of contents items comprise a web page (see Figure 8).

Regarding claim 9, Barrera discloses each of the plurality of categories and subcategories correspond to metadata when Barrera shows the descriptions corresponding to categories and subcategories (see Figure 7).

Regarding claim 10, the metadata clearly comprises information about at least one of the plurality of content items since it describes the content items (see Figure 7).

Claim 11 is met when Barrera shows keywords (see Figures 7-9).

Claims 12, 13 correspond respectively to a process for the system of claims 1, 2, thus are rejected for the same reasons stated in claims 1, 2 above.

5. Claims 43-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Marks et al (US 2002/0032019 A1).

Regarding claim 43, Marks discloses a user interface for use with a broadband creativity platform system (see Figure 1, the abstract). The claimed advertisement creating and editing tool is met when Marks shows that the FM station creates a

personalized playlist (see 0018-0021). The claimed timeline comprising a plurality of media content containers is shown in Figure 2. The claimed plurality of media content segments is met by the items to include in the playlists of Marks. Mark discloses storage area (see 0020, 0021). The claimed display area is shown in Figure 1. The claimed "wherein a first user personalizes...in a user-perceptible form" is met when Marks shows that the playlist created by the FM station is shared by multiple users (see 0009).

Regarding claim 44, Marks discloses at least one server network device programmed to provide the user interface, at least one user network device programmed to access the user interface (see 0019).

Regarding claim 45, Marks discloses that the network comprises the Internet and the user interface comprises a web site (see 0055).

Regarding claim 46, Marks discloses that the plurality of media content segments comprise digital audio (see 0067).

Regarding claim 47, clearly the advertisement creating and editing tool in the user interface of Marks comprises on-line media content creating and editing software since the media contents are from the Internet (see 0134).

6. Claims 49-54 are rejected under 35 U.S.C. 102(a) as being anticipated by Thomas (US 6,128,663).

Regarding claim 49, Thomas discloses all the claimed subject matter including selecting particular user showcase pages from the plurality of user showcase pages and displaying on the selected user showcase pages advertisements (see the abstract,

column 2, lines 51-63, column 8, lines 61-66). Note that the claimed user showcase page broadly interpreted merely reads on the customized page in Thomas. The customized page is clearly created by a user at the server and is accessible to other users who are the network browsers.

Claim 50 is met by the fact that a viewer can click to open an advertisement (see Figure 11).

Claim 51 is met when Thomas shows a network browser (see Figures 7-11).

Claim 52 is met by the fact that clicking on the advertisement shown at Figure 11 will access "Music Connection".

Claim 53 is met when Thomas shows creation of targeted advertisements (see the abstract). Clearly any targeted advertisement placement has to be sponsored on the showcase page.

Claim 54 merely reads on the fact that any advertising has to be paid for.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera et al (US 6,567,800).



Regarding claim 3, although Barrera does not specifically show that the graphical index is implemented in Flash, it would have been obvious to one of ordinary skill in the art to do so in order to benefit from readily available memory.

8. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al (US 2002/0032019 A1), in view of Boyer et al (US 2003/0066085).

Regarding claim 48, although Marks does not specifically show a website showcase page, it is well known in the art to link advertisements to advertisers showcase pages as shown by Boyer (see 0137-0141). Therefore, it would have been obvious to one of ordinary skill in the art to include such features while implementing the user interface of Marks in order to link advertisements to advertisers' sites.

9. Claims 14-17, 59, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera et al (US 6,567,800), in view of Silen et al (US 2002/0116518).

Regarding claims 14, 59, although Barrera does not specifically show that the processor is programmed to determine the bandwidth capacity and set the parameters on the computer system as claimed, it is well known in the art to do so as shown by Silen (see the abstract, 0010, 0011). Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed features while implementing the system of Barrera in order to adapt to existing systems as taught by Silen.

Regarding claims 17, 60, the system of Barera as modified by Silen discloses parameter of streaming video bit rate (see the abstract).

Claims 15, 16 merely read on the fact that the first and second files in Silen are different in size (see 0010).

10. Claims 20-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera et al (US 6,567,800), in view of Mackintosh et al (US 6,317,784).

Regarding claim 20, although Barrera does not specifically show that the processor generates a first window for presenting a user interface and a second window for advertisement as claimed, it is well known in the art as shown by Mackintosh to display the user interface and advertisements in multiple windows that slide back and forth (see Figures 7, 12). Since advertisements generate profit, it would have been obvious to one of ordinary skill in the art to include the claimed features while implementing the processor of Barrera in order to generate profit.

Regarding claim 21, although Barrera and Mackintosh do not specifically show that the graphical advertising unit is implemented in Flash, it would have been obvious to one of ordinary skill in the art to do so in order to benefit from readily available memory.

Regarding claim 22, although Barrera and Mackintosh do not specifically show periodically sliding back and forth for a predetermined interval, official notice is taken that it is well known in the art to do so in order to catch viewers' attention. Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed features in the processor of Barrera and Mackintosh in order to catch viewers' attention on the advertisements.

Regarding claims 23, 24, although Barrera and Mackintosh do not specifically show the claimed period, it would have been obvious to one of ordinary skill in the art to include any period depending on users' applications and requirements.

Regarding claim 25, Mackintosh discloses a series of advertisements (see Figure 7).

Regarding claim 26, Mackintosh discloses a streaming media advertisement (see Figure 12).

Regarding claim 27, the claimed visual display of time measurement within the second window merely reads on the fact that it is well known in the art to advertise a special price for a specific period of time for example sales price for the holiday. Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed features in the system of Barrera and Mackintosh in order to advertise special sales good only for a determined period of time.

Claims 28, 29 merely read on the fact that it is well known in the art to count down the time left before a sales ends. Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed features in the processor of Barrera and Mackintosh in order to alert viewers of when a sales ends.

Regarding claim 30, since the second window displays the counter for controlling when to revert to the first counter, clearly the processor has to be programmed to suspend the counter while the user rolls over the second window as claimed.

Claim 31 merely reads on the fact that the windows shown in Figures 7, 12 of Mackintosh can slide back and forth by the control of a user.

Claim 32 is met by the fact that the "buy now" button is visible from the first window after the second window of advertisement slides back.

Claim 33 merely reads on the fact that the user can select advertisements displayed on Figure 7 for viewing.

Regarding claim 34, Mackintosh discloses user selectable operator represented by a tab comprising indicia representative of the advertisement (see Figure 7).

Claim 35 merely reads on the fact that a window corresponding to each advertisement is opened once the user selects that advertisement (see Figure 7).

Claim 36 is met when Mackintosh shows retrieving the URL associated with an item for sale and accessing the supplier's web site (see column 14, lines 20-35).

Regarding claim 37, Mackintosh discloses a third browser window displaying a streaming media advertisement (see Figure 12).

Regarding claim 38, the claimed masking the first and second windows with an opaque layer when the third window is launched merely reads on the fact that once the URL is retrieved, the supplier's web site is accessed to allow on-line purchase (see column 14, lines 22-26).

Regarding claim 39, Mackintosh discloses suspending all functionality within the first and second windows when the third window is launched when Mackintosh shows accessing the supplier's web site and purchase on-line (see column 14, lines 22-26).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

Art Unit: 2171

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 43-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-41, 43, 45 of copending Application No. 09/906,024. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of the present application merely differs from claim 38 of the copending application by claiming an "advertisement creating and editing tool" instead of "media creating and editing tool" as recited in claim 38 of the copending application. Any advertisement includes a media.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goodwin, III et al (US 2002/0065931) teach downloading web content to a network kiosk in advance.

Frederickson et al (US 2002/0019768) teach managing advertisements.

Art Unit: 2171

Marcus (US 2002/0092019) teaches creation, distribution, assembly and verification of media.

Holtz et al (US 2002/0053078) teach producing and distributing enhanced media down streams.

Navab et al (US 2002/0094189) teach e-commerce video editing.

Errico et al (US 2002/0180774) teach presenting audio-video content.

Vanderveldt et al (US 2002/0049704) teach dynamic data mining and on-line communication of customized information.

Adams et al (US 5,483,651) teach generating a dynamic index for a file of user creatable cells.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 703-305-4134.

The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2171

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8 June 2004



**UYEN LE**  
**PRIMARY EXAMINER**